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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,846

10/07/2005

Niels Tromp

Sticht-18(P6077US00)

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MICHAELSON & ASSOCIATES

P.O. BOX 8489

RED BANK, NJ 07701-8489

EXAMINER

CADUGAN, ERICA E

ART UNIT

PAPER NUMBER

3726

MAIL DATE

DELIVERY MODE

06/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/532,846	<b>Applicant(s)</b> TROMP, NIELS	
	<b>Examiner</b> Erica E. Cadugan	<b>Art Unit</b> 3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Comment regarding Improper Multiple Dependent Claim and Election/Restrictions***

***Claim Objections***

1. Claim 29 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may refer to multiple claims only in the alternative, whereas claim 29 is drawn so as to depend from both claims 26 and 27. See MPEP § 608.01(n). Accordingly, the claim 29 has not been further treated on the merits. It is, however, noted that should claim 29 be rewritten to eliminate the improper multiple dependency, it stands drawn to a “data carrier”, and would involve a further Group VI below in the grouping of claims between which restriction is being required.

***Election/Restrictions***

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-23, drawn to a “construction element”.

Group II, claim(s) 24-25, drawn to a “mirror”.

Group III, claim(s) 26, drawn to a “method for manufacturing a construction element”.

Group IV, claim(s) 27-28, drawn to an “apparatus for manufacturing a construction element”.

3. Firstly, regarding group IV of the claims, it is noted that claims 27-28 are directed to an apparatus with an intended use of manufacturing a construction element according to claim 1, and as such, claim 27 does not actually require the limitations of claim 1, but merely requires an

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apparatus that is capable of performing the intended use of manufacturing a construction element of claim 1. Further note that regarding the claimed control apparatus including "at least units for" performing several method steps of machining, it is noted that again, such is intended use or functional type language that the apparatus must merely be capable of performing. Note that claim 27 does not positively recite that the control apparatus is a numerical controller that is programmed so as to perform the claimed method steps, but merely sets forth "at least one control apparatus" that "comprises at least units for...", and that any structure, such as a handwheel or other type of drive, for example, that enables the method steps to be performed, would meet the claim language.

That said, the inventions listed as Group IV as compared to those of Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, it has been determined *a priori*, i.e., before taking the prior art into consideration, that Group IV does not have any special technical features in common with the rest of the groups (I, II, and III), particularly since there do not appear to be any common limitations (given the same type of patentable weight) in Group IV that are in the rest of the claims of Groups I-III. (Again, it is noted that claims 27 and 28 do not encompass the limitations from the workpiece, but instead, encompass the limitations of the apparatus with an intended use of making the workpiece, and also, claim 27 is directed to the apparatus with an intended use of performing the claimed method steps, and not to a method encompassing the claimed method steps).

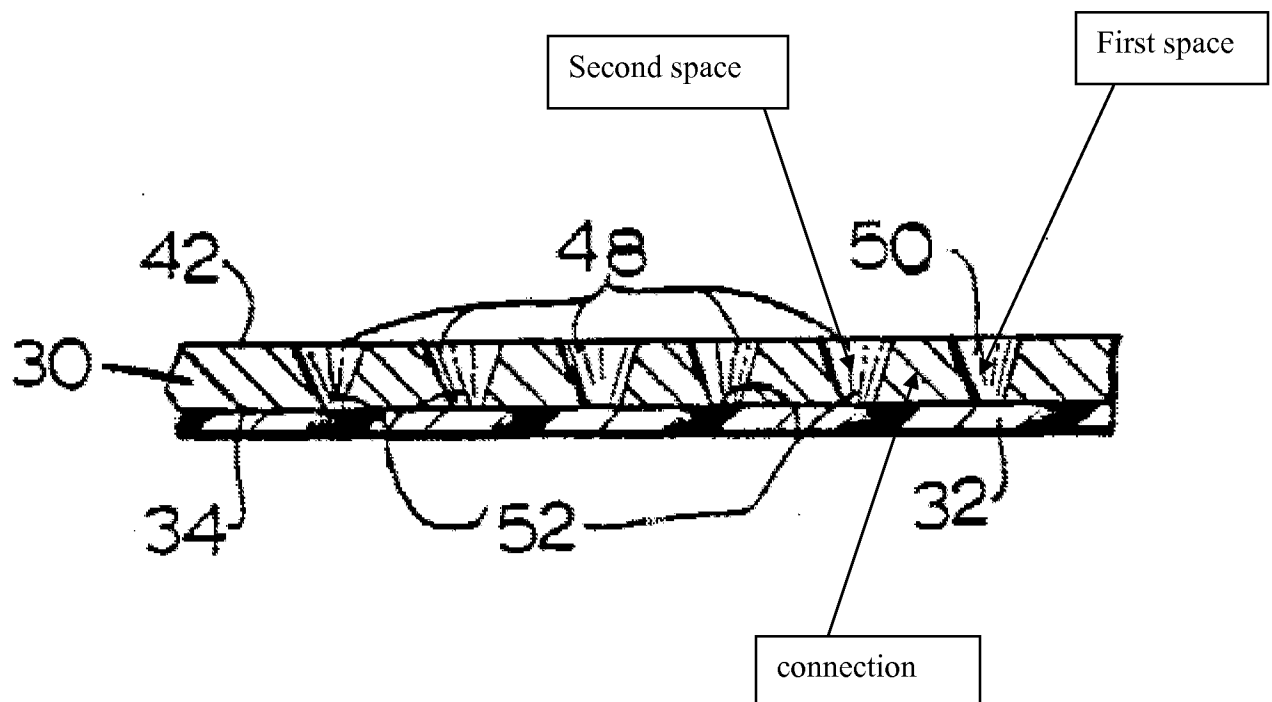
4. Additionally, specifically regarding Groups I-III, these groups listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the groups lack the same or corresponding special technical features for the following reasons: in

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accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into consideration, that the features common to all the claims do not constitute “special technical features” since they do not make a “contribution” over the prior art in light of at least U.S. Pat. No. 4,857,698 to Perun, for example.

Specifically regarding Groups I, II, and III, it is noted that the features which are common to all of the claims of Groups I, II, and III are as follows: the features of independent claim 1.

Note that Perun teaches a “construction element” in the form of a metal sheet 30 having a “first side” (such as the top surface thereof, top being with respect to Figure 3) with at least one “first opening”, such as the rightmost opening 50, and a “second side” (such as the bottom surface thereof, which is above the top surface of backing tape 32, bottom is with respect to Figure 3) having a “second opening”, such as the second opening 52 from the right as viewed in Figure 3.



First and second “spaces”, as labeled in the reproduction of Figure 3 above, are “between” the top and bottom “first” and “second” sides, and are connected to the aforescribed “first” and “second” openings, respectively. Additionally, note that the above-labeled “connection” is between the first and second (top and bottom) sides or surfaces, bounds the labeled first and second “spaces”, and the first and second side and the connection form “one integral whole. Furthermore, the second space labeled above narrows towards the second opening 52, for example.

5. Additionally, within the Groups I, II, and II of claims listed above, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

The species of Figure 4A, the species of Figure 4B, the species of Figure 4C, the species of Figure 5, the species of Figure 6, the species of Figure 7, the species of Figures 8A-8B, the species of Figures 9A- 9B, the species of Figure 10, the species of Figure 11, the species of Figures 12A-12B, the species of Figure 13, the species of Figure 14, the species of Figure 15, the species of Figure 16A, the species of Figure 16B, the species of Figure 17, and an apparently not-shown species with a spherical element surface comprising the first side and the second side.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: in accordance with the guidance set forth in MPEP section 1850, it has been determined *a posteriori*, i.e., after taking the prior art into

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consideration, that the features common to all the claims of Groups I-III, e.g., the features of claim 1, do not constitute “special technical features” since they do not make a “contribution” over the prior art in light of at least U.S. Pat. No. 4,857,698 to Perun as described in detail above, for example.

6. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species/invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474.

The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/  
Primary Examiner  
Art Unit 3726

eec

June 18, 2009